

## REMARKS

### **Formal Matters**

Claims 28-33 are pending after entry of the amendments set forth above.

Claims 16-27 are canceled without prejudice to renewal, and without intent to abandon any subject matter contained therein. Applicants expressly reserve the right to pursue the subject matter of the canceled claims in a continuing application.

Support for new claims 28-33 is found throughout the specification, including in the claims as originally filed. Support for probes for a "CGI-122 gene product" is found in figure 4, and support for "15 contiguous nucleotides" and "150 contiguous nucleotides" is found on page 6, lines 25-26.

As such, no new matter is added.

### **Restriction Requirement**

In the Office Action, the Examiner set forth a Restriction Requirement requiring election of one of the following groups of claims:

- Group I:** Claims 16-18 are drawn to detection of a cancerous colon cell comprising assaying the level of expression of SEQ ID NO:6 in a test colon cell compared to a cancerous colon cell classified in Class 435, subclass 6.
- Group II:** Claim 19 is drawn to detection of a cancerous colon cell with low metastatic potential comprising assaying the level of expression of SEQ ID NO:6 in a test colon cell compared to a cancerous colon cell with high metastatic potential classified in Class 435, subclass 6.
- Group III:** Claims 20-22 are drawn to detection of a cancerous colon cell comprising assaying the level of expression of SEQ ID NO:5 in a test colon cell compared to a cancerous colon cell classified in Class 435, subclass 6.
- Group IV:** Claim 23 is drawn to detection of a cancerous colon cell with low metastatic potential comprising assaying the level of expression of SEQ ID NO:5 in a test colon cell compared to a cancerous colon cell with high metastatic potential classified in Class 435, subclass 6.
- Group V:** Claims 24-26 are drawn to detection of a cancerous colon cell comprising assaying the level of expression of SEQ ID NO: 7 in a test colon cell compared to a cancerous colon cell classified in Class 435, subclass 6.

**Group VI:** Claim 27 is drawn to detection of a cancerous colon cell with low metastatic potential comprising assaying the level of expression of SEQ ID NO:7 in a test colon cell compared to a cancerous colon cell with high metastatic potential classified in Class 435, subclass 6.

Applicants respectfully traverse this Restriction Requirement.

Regarding restriction, 35 U.S.C. 121 states that “[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions.”

With regard to inventions involving nucleotide sequences, the MPEP §803.03 states that “nucleotide sequences encoding the same protein are not considered to be independent and distinct inventions and will continue to be examined together.”[emphasis added]. As such, when an invention involves sequences encoding the same protein, it is not proper to restrict the invention to a single sequence.

Applicants submit that SEQ ID NOS:5, 6 and 7 are sequences encoding the same protein, CGI-122, Genbank accession number AF151880.1. This observation is described at Table 4, page 59, lines 21-23 of the subject application. The relationship between SEQ ID NOS: 5, 6 and 7, and the cDNA encoding the CGI-122 protein is shown in Appendix A accompanying this response. SEQ ID NOS: 5, 6 and 7, lie very close to each other in the CGI-122 coding sequence, and, in fact, SEQ ID NOS: 5 and 7 are overlapping sequences. As such, SEQ ID NOS:5, 6 and 7 are sequences encoding the same protein.

Because SEQ ID NOS:5, 6 and 7 encode the same protein, applicants submit that that, pursuant to MPEP §803.03, applicants respectfully submit that the restriction requirement be reconsidered and withdrawn.

**Solely because applicants are required to make a provisional election in order to ensure they are responsive, applicants hereby provisionally elect to prosecute the subject matter of Group III. The newly presented claims 28-33 correspond to subject matter of Group III.**

Applicants expressly reserve the right under 35 USC §121 to file a divisional application directed to the non-elected subject matter during the pendency of this application.

**Species Election**

The Office further required election of a single method of detection: a) hybridization or b) PCR.

Applicants hereby elect species a) hybridization (claims 30 and 38), for prosecution.

Applicants assert that the subject matter of Claim 28 encompasses a reasonable number of species and that Claim 28 is generic to all the claimed species. As such, according to MPEP §809(c), Claim 28 should be examined by the Office if claims directed to the elected species are found allowable.

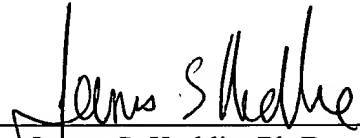
The claims readable on the elected species, a) hybridization, are Claims 28 and 30-33.

The claims readable on the non-elected species, b) PCR amplification, are Claims 28-29 and 32-33.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-0815 Order No. 2300-1490DIV.

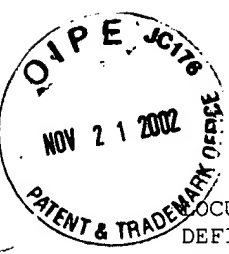
Respectfully submitted,  
BOZICEVIC, FIELD & FRANCIS LLP

Date: 11-15-2002

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APPENDIX A: Genbank Accession number AF151880

LOCUS AF151880 1174 bp mRNA linear PRI 18-MAY-2000  
DEFINITION Homo sapiens CGI-122 protein mRNA, complete cds.  
ACCESSION AF151880  
VERSION AF151880.1 GI:4929712  
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BASE COUNT 300 a 299 c 307 g 268 t

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SEQ ID NO:7

SEQ ID NO:5